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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH A. WALKER JR. and VYACHESLAV
NYKYFOROV

Appeal 2009-009799
Application 10/748,364
Technology Center 2100

Before JAY P. LUCAS, ST. JOHN COURTENAY III, and
JAMES R. HUGHES, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-3, 5, 6, 8-21, 23, 24, and 26-36, which are all the claims pending in the application. Claims 4, 7, 22, and 25 were cancelled during prosecution. We have jurisdiction under 35 U.S.C. § 6(b).

We Reverse.

Invention

Appellants' invention relates generally to computer-implemented automated electronic product design. (Spec. 1). More particularly, the invention on appeal is directed to "[c]omputer-implemented electronic document design systems and methods allowing a user to integrate user-specific location maps into custom printed products." (Abstract).

Representative Claim

1. A computer-implemented method for use in creating an electronic design of a two-sided product intended for subsequent printing, the method comprising

providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user,

providing a tool allowing the user to supply at least text to be printed on the first side,

providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed,

providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area,

making electronic map information available to a server computer system, the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps,

in response to information received from the client computer system identifying a location within the relatively large geographical

area, obtaining a relatively high resolution user map from the map information, the user map covering a relatively small geographical area that includes at least the identified location,

generating a lower resolution display map version of the user map, the display map being suitable for displaying at the client,

transmitting the display map to the client for displaying to the user, *receiving a description of the product design from the client, the description identifying at least a portion of the display map, and*

associating the identified portion of the display map with the corresponding higher resolution map information such that when the product is printed the map area on the second side of the product design will be printed using the higher resolution map information.

(emphasis added)

Rejection

Claims 1-3, 5, 6, 8-21, 23, 24, and 26-36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of von Kaenel (US 7,107,285 B2, Sep. 12, 2006) and Appellants' own Admissions ("admitted prior art" hereinafter "APA").

Dependent claims 21, 23, 24, and 26-28

At the outset, we observe that page 49 of the principal Brief (filed March 27, 2008) is missing from the official PTO electronic file wrapper (e-DAN). Thus, either (1) the page was missing in the Brief as originally filed, or (2) the PTO did not scan page 49 and the page is presumably lost.

In particular dependent claims 21, 23, 24, and 26-28 are missing from the "Claims Appendix" to the Brief (Brief, missing page 49). *Cf.* App. Brief

page 4: “Pending claims 1-3, 5, 6, 8-21, 23, 24, and 26-36 have been twice rejected and are the subject of this appeal. Claims 4, 7, 22, 25 have been canceled. No other claims are pending.” *Accord* Reply Brief pg. 2, filed Aug. 15, 2008.

In order to expedite consideration of this appeal, we have considered dependent claims 21, 23, 24, and 26-28 as presented in the amendment filed on July 12, 2007, which was the last amendment entered before the Final Rejection (mailed Sept. 27, 2007) and the Notice of Appeal (filed Dec. 27, 2007).

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

Under §103, did the Examiner err in finding that the combination of von Kaenel and APA would have taught or suggested “receiving a description of the product design from the client, the description identifying at least a portion of the display map,” where the display map is of a lower resolution than the higher resolution map information that is printed on the product, within the meaning of independent claim 1 and the commensurate language of independent claims 12, 19, and 30?

ANALYSIS

Appellants contend that the cited references, namely von Kaenel, fail to teach or suggest, “receiving a description of the product design from the client, the description identifying at least a portion of the display map.” (App. Br. 29).

We begin our analysis with claim construction. We observe that Appellants’ Fig. 2 depicts active controls that allow a user to select a desired type of product for a more detailed presentation of design options. “By way of example, Fig. 2 shows promotional images for business cards 210, postcards 220, stationary 230, folded cards 240, return address labels 250, and brochures 260. (Fig. 2, Spec. para. [0025]). The Specification also guides that

[i]t will be understood that the invention is not limited to documents that are intended for eventual printing on paper, but could as well be readily adapted to a wide range of products that a user may wish to customize, such as items of clothing, product containers, promotional goods, and so forth.

(Spec. para. [0025]). Thus, we conclude that the broadest reasonable interpretation of Appellants’ claims consistent with the Specification broadly encompasses printing on *any* type of product. Therefore, the claimed invention is not limited to printing only on paper products such as postcards, stationary, brochures, and the like.

Appellants additionally contend that Von Kaenel does not teach or suggest “associating the identified portion of the display map with the corresponding higher resolution map information such that when the product

is printed the map area on the second side of the product design will be printed using the higher resolution map information.” (App. Br. 30; claim 1).

We focus our analysis on the display resolution of the recited claim term “display map.” (Claim 1). We note that claim terms are not interpreted in a vacuum, devoid of the context of the claim as a whole. *See Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999) (“proper claim construction . . . demands interpretation of the entire claim in context, not a single element in isolation.”); *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) (“While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered....”).

Here, in considering the disputed limitation of “receiving a description of the product design from the client, the description identifying at least a portion of the *display map*,” we observe that the plain language of the claim requires that the *display map* is of a lower resolution than the higher resolution map information that is printed on the product. (*See* claim 1, “generating a lower resolution display map version of the user map, the display map being suitable for displaying at the client” . . . “associating the identified portion of the display map with the corresponding higher resolution map information such that when the product is printed the map area on the second side of the product design will be printed using the higher resolution map information.”)

Therefore, in considering the language of claim 1 as a whole, we conclude that claim 1 requires that a *description of the product design* is received from a client, where the description must identify at least a portion

of a *display map* that is of a *lower resolution than the higher resolution map information* that is printed on the product.

In the rejection, the Examiner relies on von Kaenel at column 65 (lines 19-67) for teaching or suggesting a lower resolution display map. (Ans. 4). However, in reviewing this portion of von Kaenel, we only find a teaching of supported screen resolutions, and also a separate teaching of a print map menu selection (not cited by the Examiner, col. 66, l. 37).

Even if we *arguendo* (without deciding) accept the Examiner's explanation regarding the disputed claim limitation of *receiving a description of the product design from the client* (Ans. 22-23), on this record, we do not find the Examiner has established that von Kaenel would have taught or fairly suggested *the description identifying at least a portion of the display map is a display map that is of a lower resolution than the higher resolution map information* that is printed on the product. Moreover, the Examiner has not established that APA remedies the deficiencies of von Kaenel.

While the Examiner is correct that the particular map contents of the claimed "map information" is non-functional descriptive material (Ans. 23), we nevertheless must accord weight to the two different resolutions (lower and higher) that are positively recited in each independent claim on appeal. Therefore, for essentially the same reasons argued by Appellants in the Briefs, as discussed above, on this record we find the weight of the evidence supports the Appellants' position.

Accordingly, we agree with Appellants that the Examiner erred in finding that the cited combination of references would have taught or suggested "receiving a description of the product design from the client, the

description identifying at least a portion of the display map,” where the display map is of a lower resolution than the higher resolution map information that is printed on the product, within the meaning of representative claim 1. We observe that independent claims 12, 19, and 30 recite commensurate limitations. Accordingly, we reverse the Examiner’s obviousness rejection of independent claims 1, 12, 19, and 30, as well as the rejection of each associated dependent claim.

DECISION

We reverse the § 103 rejection of claims 1-3, 5, 6, 8-21, 23, 24, and 26-36.

ORDER

REVERSED

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